

## REMARKS

### Summary of the Office Action and this Amendment

In paragraph 4 of the office action, the examiner states:

The invention as disclosed in claims 1-63 are rejected under 35 U.S.C. § 101 as being non-statutory subject matter.... "Moreover, ... when an abstract concept has no claimed practical application, it is not patentable."

In paragraph 5 of the office action, the examiner states:

*No preemption is permitted* i.e., when a claim is so broad that it reads on both statutory and nonstatutory subject matter, *it must be amended*. A claim that recites a computer that solely calculates a mathematical formula is not statutory. In other words, one may not patent a process that comprises every "substantial practical application" of an abstract idea, because such a patent in "practical effect would be a patent on the [abstract idea] itself." Regarding claims 1-63 "a method for identifying at least one property of data" would in fact cover virtually all forms of data or information identification. Nothing is specified in the claims to limit the invention to a particular application .... Without clearly stating in the claim a particular application, it *preempts* all forms of data or information identification. Where as, the courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena....

In paragraph 6 of the office action, the examiner states:

The claims fail to provide a "useful, concrete or tangible result." Moreover, there must be a practical application, by either (1) transforming (physical thing) or (2) by having the FINAL RESULT (not the steps) achieve or produce a "useful" (specific, substantial, AND credible), "concrete" (substantially repeatable/non-unpredictable), AND "tangible" (real world/non-abstract) result. Moreover, the claims are directed to an abstract idea rather than a practical application of an abstract idea which would produce a "useful, concrete or tangible results." Accordingly, the claims fail to provide a practical application and is insufficient to establish a real world "tangible" result ....

In paragraph 7 of the office action, the examiner states:

Devoid of such, applicant's claimed invention is an abstract e.g., a computational model or a mathematical manipulation of a function or equation. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might inherently have some usefulness ....

In paragraph 8 of the office action, the examiner states:

A claim is limited to a practical application when the invention as claimed, produces a concrete, tangible and useful result; i.e., the invention recites a steps (sic) or a process or act of producing something that is concrete, tangible and useful. (citation omitted.) The claimed invention as a whole must accomplish a practical application.

That is, it must produce a "useful, concrete and tangible result." (citation omitted.) Remember, the claims define the property rights provided by a patent, and thus require careful scrutiny. Therefore, it is not enough to set forth (sic) invention in the specification. The claims must also reflect the scope and breath of applicant's invention. (citation omitted.) Limitations appearing in the specification but not recited in the claim are not read into the claim. (citation omitted.) The situation in this application appears to be more difficult since it does not appear that the practical application is contained within the specification.

In paragraph 10 of the office action, the examiner states:

Claims 1, 39, 44, 57, 58 & 60-63 are rejected under 35 U.S.C. 102(b) as being anticipated by *Hutchison* (USPN 5,802,506).

In paragraph 11 of the office action, the examiner states:

Claims 2-38, 40-43, 45-49 & 59 is/are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In paragraph 12 of the office action, the examiner states:

Allowance of claims 50-56 are dependent upon the resolution of the outstanding issues shrouding 35 U.S.C. § 101.

In this Amendment, the applicant has amended claims 1, 3, 13, 14, 26, 27, 39, 44, 50, 51, 56, and 58 and has canceled claims 10, 32-38, 43, 46, 57, and 59-63. Support for the amendments can be found, for example, in the specification in paragraphs 26, 27, 29, 31, 33, 35, 48, and 54. No new matter has been added. Claims 1-9, 11-31, 39-42, 44-45, 47-56, and 58 are now pending in the application.

Claim Rejections - 35 U.S.C. 101

As mentioned above, in paragraph 4 of the office action, the examiner states:

The invention as disclosed in claims 1-63 are rejected under 35 U.S.C. § 101 as being non-statutory subject matter.... "Moreover, ... when an abstract concept has no claimed practical application, it is not patentable."

In paragraph 5 of the office action, the examiner states:

*No preemption is permitted* i.e., when a claim is so broad that it reads on both statutory and nonstatutory subject matter, *it must be amended*. A claim that recites a computer that solely calculates a mathematical formula is not statutory. In other words, one may not patent a process that comprises every "substantial practical application" of an abstract idea, because such a patent in "practical effect would be a patent on the [abstract idea] itself." Regarding claims 1-63 "a method for identifying at least one property of data" would in fact cover virtually all forms of data or information identification. Nothing is specified in the claims to limit the invention to a particular application .... Without clearly stating in the claim a particular application, it *preempts* all forms of data or information identification. Where as, the courts have also held that a claim may not preempt ideas, laws of nature or natural phenomena....

In paragraph 6 of the office action, the examiner states:

The claims fail to provide a "useful, concrete or tangible result." Moreover, there must be a practical application, by either (1) transforming (physical thing) or (2) by having the FINAL RESULT (not the steps) achieve or produce a "useful" (specific, substantial, AND credible), "concrete" (substantially repeatable/non-unpredictable), AND "tangible" (real world/non-abstract) result. Moreover, the claims are directed to an abstract idea rather than a practical application of an abstract idea which would produce a "useful, concrete or tangible results." Accordingly, the claims fail to provide a practical application and is insufficient to establish a real world "tangible" result ....

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Devoid of such, applicant's claimed invention is an abstract e.g., a computational model or a mathematical manipulation of a function or equation. A process that merely manipulates an abstract idea or performs a purely mathematical algorithm is non-statutory despite the fact that it might inherently have some usefulness ....

In paragraph 8 of the office action, the examiner states:

A claim is limited to a practical application when the invention as claimed, produces a concrete, tangible and useful result; i.e., the invention recites a steps (sic) or a process or act of producing something that is concrete, tangible and useful. (citation omitted.) The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible

result." (citation omitted.) Remember, the claims define the property rights provided by a patent, and thus require careful scrutiny. Therefore, it is not enough to set forth (sic) invention in the specification. The claims must also reflect the scope and breath of applicant's invention. (citation omitted.) Limitations appearing in the specification but not recited in the claim are not read into the claim. (citation omitted.) The situation in this application appears to be more difficult since it does not appear that the practical application is contained within the specification.

The independent claims, as presented in this amendment, are claims 1, 3, 13, 14, 26, 27, 39, 44, 50, 51, and 58.

Claims 1, 3, 13, 14, 26, 27, 39, 44, 50, as amended herein recite in part:

A computer readable storage medium tangibly embodying a program of machine-readable instructions executable by a digital processing apparatus to perform a method for identifying the risk presented by a shipping container, the method comprising the following operations:

receiving data regarding the shipping container;

....

Claim 51 as amended herein recites in part:

A computer readable storage medium tangibly embodying machine-readable code executable by a digital processing apparatus for identifying the risk presented by a shipping container, the code comprising:

a data integrity module configured to examine integrity of  
the data, wherein the data regards the shipping container;

...

Claim 58 as amended herein recites in part:

A profiling system, comprising:

a storage; and

a processor coupled to the storage, wherein the processor is  
programmed to perform the following operations for identifying  
the risk presented by a shipping container:

receiving data regarding the shipping container;

...

The applicant submits that each of the independent claims presented herein  
provides the useful, concrete, and tangible result of identifying the risk presented by a  
shipping container. Consequently, the applicant submits that all of the claims presented  
herein are directed to statutory subject matter, and that the claim rejections under 35  
U.S.C. 101 should be withdrawn.



Claim Rejections - 35 U.S.C. 102

a. Legal Criteria 35 U.S.C. 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

*Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). . . . "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

MPEP § 2131 (8<sup>th</sup> ed., rev. 5, Aug. 2006).

b. Discussion Regarding the 35 U.S.C. 102 Rejections

As mentioned above, in paragraph 10 of the office action, the examiner states:

Claims 1, 39, 44, 57, 58 & 60-63 are rejected under 35 U.S.C. 102(b) as being anticipated by *Hutchison* (USPN 5,802,506).

Also as mentioned above, in paragraph 11 of the office action the examiner states:

Claims 2-38, 40-43, 45-49 & 59 is/are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The independent claims, as presented in this amendment, are claims 1, 3, 13, 14, 26, 27, 39, 44, 50, 51, and 58. Each of the independent claims presented in this amendment is now in a form the examiner stated would be allowable with regard to 35 U.S.C. 102(b), as is discussed in the following paragraphs:

Claim 1 has been amended herein to include the limitations of claim 10, and claim 10 has been canceled. Claim 10 was dependent upon only claim 1. Thus, claim 1 includes all of the limitations of claim 10, and the base claim (claim 1), and therefore should be allowable in view of the examiner's statement above that claim 10 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 3, has been amended herein in independent form including all of the limitations of the base claim (claim 1) and any intervening claims, and consequently, in view of the examiner's statement regarding rewriting claims in independent form, the applicant submits that claim 3 should be allowable.

Claim 13, has been amended herein in independent form including all of the limitations of the base claim (claim 1) and any intervening claims, and consequently, in

view of the examiner's statement regarding rewriting claims in independent form, the applicant submits that claim 13 should be allowable.

Claim 14, has been amended herein in independent form including all of the limitations of the base claim (claim 1) and any intervening claims, and consequently, in view of the examiner's statement regarding rewriting claims in independent form, the applicant submits that claim 14 should be allowable.

Claim 26, has been amended herein in independent form including all of the limitations of the base claim (claim 1) and any intervening claims, and consequently, in view of the examiner's statement regarding rewriting claims in independent form, the applicant submits that claim 26 should be allowable.

Claim 27, has been amended herein in independent form including all of the limitations of the base claim (claim 1) and any intervening claims, and consequently, in view of the examiner's statement regarding rewriting claims in independent form, the applicant submits that claim 27 should be allowable.

Claim 39 has been amended herein to include the limitations of claim 43, and claim 43 has been canceled. Claim 43 was dependent upon only claim 39, Thus, claim 39 includes all of the limitations of claim 43, and the base claim (claim 39), and therefore should be allowable in view of the examiner's statement above that claim 43 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 44 has been amended herein to include the limitations of claim 46, and claim 46 has been canceled. Claim 46 was dependent upon only claim 44, Thus, claim 44 includes all of the limitations of claim 46, and the base claim (claim 44), and therefore should be allowable in view of the examiner's statement above that claim 46 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Independent claims 50 and 51 (and dependent claims 52-56) were not rejected under 35 U.S.C. 102(b).

Claim 58 has been amended herein to include the limitations of claim 59, and claim 59 has been canceled. Claim 59 was dependent upon only claim 58, Thus, claim 58 includes all of the limitations of claim 59, and the base claim (claim 58), and

therefore should be allowable in view of the examiner's statement above that claim 59 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In summary, all of the currently pending independent claims presented in this amendment, except independent claims 50 and 51 which were not rejected under 35 U.S.C. 102(b), have been amended herein to be placed into a form the examiner stated would be allowable with regard to 35 U.S.C. 102(b).

The applicant submits that the examiner's rejection of claims under 35 102(b) based on Hutchison, is misplaced, as was argued in the preceding amendment. However, because all of the claims that were rejected under 35 U.S.C. 102(b) have been canceled, or have been amended to place them in a form the examiner stated would be allowable, to expedite allowance of the application, there is no need to presently debate the appropriateness of the 35 U.S.C. 102(b) claim rejections. In summary, the applicant submits that all of the claims as presented herein are in a form the examiner stated would be allowable with respect to 35 U.S.C. 102(b).

#### Dependent claims and amendments in general

The applicant submits that dependent claims are statutory and novel for at least the reasons that their respective independent claims are statutory and novel. Some of the claim amendments in this amendment were made to correct typographical errors and to clarify the wording.

### Conclusion

The applicant submits that, in view of the amendments to the claims herein, all of the claims presented herein provide the useful, concrete, and tangible result of identifying the risk presented by a shipping container. Consequently, the applicant submits that all of the claims presented herein are directed to statutory subject matter, and that the claim rejections under 35 U.S.C. 101 should be withdrawn. Also, because all of the claims that were rejected under 35 U.S.C. 102 were either canceled or amended herein to be placed into a form the examiner said would be allowable, the applicant submits that all of the claims should be allowable in view of 35 U.S.C. 102. Thus, the applicant submits that the application is in condition for allowance, and the applicant requests entry of this amendment, and reconsideration and further examination, and allowance of the application.

Respectfully submitted,

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